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OFFICE OF PETITIONS

In re Application of
Oshima, et. al.
Application No. 10/783,588
Filed: February 23, 2004
Attorney Docket No. 2004_0285

DECISION GRANTING
PETITION UNDER
37 CFR §1.183

This is a decision on the March 9, 2007, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is GRANTED.

A fee of \$400.00 has been received and processed for the petition under 37 CFR 1.183.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on February 23, 2004. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on February 23, 2004 is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

The reissue application was originally filed with a specification that did not comply with 37 CFR 1.173(a)(1). On February 23, 2004, a substitute specification was filed together with a preliminary amendment. Within the "REMARKS" section of the preliminary amendment, applicant states: "Since this is a reissue application, the substitute specification includes bracketing and underlining to show the changes relative to the patent specification."

Petitioner is requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that "in a telephone conversation with the Examiner in connection with reissue application 09/686,464, which is also a divisional application of reissue application 09/244,037, the Examiner required a substitute specification and indicated that substitute specifications would be required in all of the related reissue applications of U.S. patent 5,600,672 if the same specification amendments were to be entered.¹"

This basis is considered to be sufficient for granting the petition. The rule will be waived to comply with the requirement of the examiner, since there is no other way to present the required substitute specification, and the requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on February 23, 2004 is accepted, and will be entered.
3. The reissue application file is being forwarded to the Technology Center for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Amelia Au, Office of Petitions, at (571) 272-7414.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

¹ No other record of the referenced telephone conversation can be found in this application file.